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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,968	02/20/2004	Kevin J. Williams	W1107/20009	9607

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EXAMINER
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HARRIS, ALANA M

ART UNIT	PAPER NUMBER
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1643

NOTIFICATION DATE	DELIVERY MODE
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07/09/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@crbcp.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/782,968	<b>Applicant(s)</b> WILLIAMS, KEVIN J.	
	<b>Examiner</b> Alana M. Harris, Ph.D.	<b>Art Unit</b> 1643	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 May 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 241, 244, 245, 248, 249, 252, 253, 256, 265-276, 278-289, 291-297, 299-303, 305-317, 319-329, 331-336, 338-348, 350-355, 357-359 and 361-370 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Disposition of Claims: Claims pending in the application are 241,244,245,248,249,252,253,256,265-276,278-289,291-297,299-303,305-317,319-329,331-336,338-348,350-355,357-359 and 361-370.

## **DETAILED ACTION**

### ***Response to Arguments and Amendments***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action mailed January 20, 2010 is persuasive and, therefore, the finality of that action is withdrawn.

2. Claims 241, 244, 245, 248, 249, 252, 253, 256, 265-276, 278-289, 291-297, 299-303, 305-317, 319-329, 331-336, 338-348, 350-355, 357-359 and 361-370 are pending.

Claims 242, 250, 277, 290, 298, 304, 318, 330, 337, 349, 356 and 360 have been cancelled.

Claims 241, 244, 245, 249, 252, 253, 265, 272-274, 276, 278, 279, 282, 289, 291, 297, 399-301, 303, 305-307, 317, 319, 320, 322, 329, 332, 336, 338, 339, 341, 348, 350, 351, 355, 357-359, 361-363, 365, 367 and 369 have been amended.

Claims 241, 244, 245, 248, 249, 252, 253, 256, 265-276, 278-289, 291-297, 299-303, 305-317, 319-329, 331-336, 338-348, 350-355, 357-359 and 361-370 are examined on the merits.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Withdrawn Rejections***

***Claim Rejections - 35 USC § 112***

4. The **NEW MATTER REJECTION** of claims 309-316 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in light of Applicant's arguments presented on page 27 of the Remarks submitted May 6, 2010.

5. The rejection of claims 241, 244, 245, 248, 249, 251-253, 256, 265-276, 278-303, 305-317, 319-329, 331-336, 338-348, 350-355, 357-359 and 361-370 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in light of Applicant's amendment to the claims submitted May 6, 2010. Claims 242, 250, 277, 290, 298, 304, 318, 330, 337, 349, 356 and 360 have been cancelled.

***Claim Rejections - 35 USC § 102***

6. The rejection of claims 241, 245, 248, 249, 253, 256 and 265-276 under 35 U.S.C. 102(b) as being anticipated by Jackowski et al./ U.S. Patent application publication number 2003/0119074 A1 (December 20, 2001) is withdrawn in light of the amendments to some of the claims and arguments set forth May 6, 2010.

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7. The rejection of claims 241, 244, 245, 248, 249, 252, 253, 256 and 256-276, 278, 279, 280-289, 291-297, 299-303 and 305-316 under 35 U.S.C. 102(e) as being anticipated by McCarthy/ U.S. Patent Application Publication number 2003/0166017 A1 (filed November 9, 2001) is maintained. Claims 242, 250, 277, 290, 298 and 304 have been cancelled.

***Claim Rejections - 35 USC § 103***

8. The rejection of claims 241, 244, 245, 248, 249, 252, 253, 256-276, 278-289, 291-297, 299-303 and 305-316 under 35 U.S.C. 103(a) as being unpatentable over WO 98/07035 (published 19 February 1998), and further in view of McCarthy/ U.S. Patent Application Publication number 2003/0166017 A1 (filed November 9, 2001) is withdrawn in light of Applicant's amendments and arguments submitted May 6, 2010. Claims 242, 250, 277, 290, 298 and 304 have been cancelled.

***Double Patenting***

9. The provisional rejection of claims 241, 244, 245, 248, 249, 252, 253, 256, 265-276, 278-289, 291-297, 299-303, 305-317, 319-329, 331-336, 338-348, 350-355, 357-359 and 361-370 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 67 and 168-182 of copending Application No. 10/525,610 (filed March 24, 2006) is withdrawn in light of the abandonment of the said copending application.

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Claims 242, 250, 277, 290, 298, 304, 318, 330, 337, 349, 356 and 360 have been cancelled.

### ***New Grounds of Objection***

#### ***Claim Objections***

10. Claim 309 is objected to because of the following informality: at step 7 within the claim contains the term “the” twice. Correction is required.

### ***New Grounds of Rejection***

#### ***Double Patenting***

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

*Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 241, 244, 245, 248, 249, 252, 253, 256, 265-276, 278-289, 291-297, 299-303, 305-317, 319-329, 331-336, 338-348, 350-355, 357-359 and 361-370 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 7,655,411 B2 (issued February 2, 2010). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim set of both documents share the active method step of measuring an individual's plasma level of thrombospondin fragment or fragments with a binding agent, wherein the fragment sizes are the same in order to detect the presence and/or clinical course of a neoplastic disease.



Applicant asserted previously that a terminal disclaimer submitted in application 10/419,462 that corresponds to said patent should obviate the pending rejection, see Remarks submitted April 27, 2009, page 7. The Examiner prematurely withdrew the rejection in the Final Action mailed January 20, 2010. Applicants need to submit a terminal disclaimer in the present case to obviate this pending rejection.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Alana M. Harris, Ph.D. whose telephone number is (571)272-0831. The Examiner works a *flexible schedule*, however she can normally be reached between the hours of 8 am to 8 pm, Monday through Saturday.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Larry R. Helms, Ph.D. can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alana M. Harris, Ph.D.  
01 July 2010

/Alana M. Harris, Ph.D./  
Primary Examiner, Art Unit 1643